

**REMARKS**

Claims 43 and 45-62 are pending in the application. Applicant respectfully requests consideration and allowance of the subject application in view of the foregoing amendments and the following remarks.

### § 103 Rejection

**Claims 43 and 45-62** stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 6,367,019 B1 (hereinafter “Ansell”) in view of U.S. Patent No. 5,745,678 (hereinafter “Herzberg”).

In making out the rejection of **claim 43**, the Office argues that Ansell discloses most of the subject matter of this claim, but is silent as to the term “random” as such pertains to retrieving data. For this subject matter, the Office relies on Herzberg and argues that its combination with Ansell would render the subject matter of this claim obvious. As a motivation for the suggested combination, the Office states that such motivation would be “in order to more *efficiently* validate the multimedia program to reduce the possibility of forgery”. See, Office Action, page 5, first paragraph.

Applicant submits that the Office has not established a *prima facie* case of obviousness for at least this following reason. The Office's stated motivation – that of improving efficiency – is too general and lacking in the particularity that is required when making out a *prima facie* case of obviousness. See, e.g., *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ("particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed").

In addition, the Office itself has provided a paper, available at the following link:

that describes proper and improper rejections made under §103(a). Particularly instructive is Example 17 that appears in Section V of the paper illustrating an improper §103(a) rejection which is based upon a proposed motivation that is simply too general and lacking in particularity. This example is reproduced below in its entirety for the Office's convenience:

## **V. Examples of Improper Rejection under 35 U.S.C. 103**

Example 17: Improper rejection based upon hindsight - general motivation statement.

### a. The claimed invention

The invention is drawn to a smart card containing a tracking mechanism, which tracks shopping preferences of consumers by recording the type, quantity, and dates of purchase for a pre-selected group of products. The smart card is useful in a system and method for introducing new and alternative products that are of the same type as products normally purchased by the shopper. The smart card records the shopper's purchases and submits an automatic notification to the shopper when a quantity threshold is achieved for the pre-selected products. This notification will encourage the consumer to consider alternative products by providing the consumer incentives, such as a pricing discount, to purchase an alternative product.

Claim 1:

1           A method for using a smart card in a marketing analysis program  
2           designed to introduce new products, the method comprising the steps of:

3           storing product information on the smart card when said  
4           products are purchased by a consumer wherein said information  
5           including type, quantity and dates of the product purchased;

6           identifying for each product a threshold for each of said type,  
7           quantity and dates of products purchased;

8           determining an incentive for an alternative product based on  
9           said threshold; and

10           automatically notifying said consumer when said threshold is  
11           reached for a given product identified on the smart card and  
12           providing the consumer with said incentive, whereby the incentive  
13           encourages the consumer to consider alternative products.

14           **b. Evidence**

15           Reference A discloses smart card that tracks consumer preferences  
16           by recording the type, quantity, and dates of purchase of pre-selected  
17           products to determine trends in consumer purchases. The smart card is  
18           periodically read by a scanner to determine its contents for market analysis.  
19           In return for using the smart card and participating in the marketing  
20           program, the user is provided with free product coupons for products that  
21           are normally purchased by the shopper.

22           Reference B discloses a traditional consumer incentive program that  
23           provides coupons for the purchase of named products based upon the  
24           consumer's purchase of those same products to promote customer loyalty.

25           **c. Poor statement of the rejection**

26           Claim 1 is rejected under 35 U.S.C. 103 as being unpatentable over  
27           Reference A in view of Reference B. Reference A discloses the  
28           conventional use of a smart card to track consumer preferences and provide  
29           incentives. However, Reference A does not disclose the automatic  
30           notification to consumer providing incentives. Reference B discloses

1 providing incentives to consumers to purchase the desired products. *It*  
2 *would have been obvious to combine Reference A's smart card with*  
3 *Reference B's incentive to consumers because the combination would*  
4 *allow Reference A's smart card to be more efficient.*

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6 **d. Analysis**

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*The motivation, improve efficiency, is too general because it could cover almost any alteration contemplated of Reference A and does not address why this specific proposed modification would have been obvious.* Additionally, there is nothing in either of references that would suggest automatically notifying the consumer when reaching a threshold nor is there anything in either reference that would suggest the notifying step. Finally, although Reference B teaches a traditional coupon scheme to promote customer loyalty, there is no suggestion, other than applicant's disclosure, to employ this scheme to promote the introduction of new and alternative products. **The rejection is improper.**

Accordingly, the Office's own example illustrates that a motivation of improving efficiency is simply improper and does not support a *prima facie* case of obviousness. Accordingly, for at least this reason, the Office has failed to establish a *prima facie* case of obviousness and this claim is allowable.

**Claims 45-49** are allowable as depending from an allowable base claim.

In making out the rejection of **claim 50**, the Office essentially makes that same argument as was made in claim 43. For the reasons stated above, the Office has failed to establish a *prima facie* case of obviousness.

**Claims 51-57** are allowable as depending from an allowable base claim.

In making out the rejection of **claim 58**, the Office essentially makes that same argument as was made in claim 43. For the reasons stated above, the Office has failed to establish a *prima facie* case of obviousness.

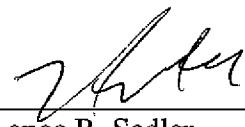
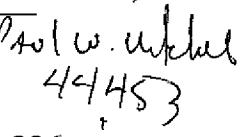
1                   **Claims 59-62** are allowable as depending from an allowable base claim.  
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4                   **Conclusion**  
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7                   For at least the foregoing reasons, claims 43 and 45-62 are allowable over the  
8 prior art of record. In the event that the Office's next action is to be anything other than  
9 issuance of a Notice of Allowability, Applicant intends to appeal this case.  
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12                   Respectfully Submitted,  
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14                   Date: 3/17/06  
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